

REMARKS

The Applicants respectfully request further examination and consideration in view of the amendment above and arguments set forth fully below. Within the Office Action, Claims 1-17 were rejected. In this response, the Applicants have amended Claims 1-11, 16 and 17. Currently, Claims 1-17 are pending in this application.

Claims 1, 2, 5, 6, 8, 16 and 17

Within the Office Action, Claims 1, 2, 5, 6, 8, 16 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,754,528 to Lyons et al. (hereinafter "Lyons") in view of U.S. Patent No. 4,580,347 to McKnight (hereinafter "McKnight").

Lyons teaches a locking apparatus which consists of a plate 25 bent over at one end to form a lip 18 near the bottom of the object 17. The apparatus in Lyons also has an angled extension 19 and a "U" spring clip 26 mounted to the lateral face 17 of the object 30 such that the lip 18 abuts the lateral face 17 while the angled extension 20 extends over the top of the object 30. The apparatus in Lyons has a gap 28 within the spring clip 26 which is positioned between the plate 25 and the lateral face 17, wherein the gap 28 receives and encircles the belt. Lyons also teaches that the first gap 28 between the plate 25 and the lateral face 17 is wide enough to accommodate the wearer's belt. The belt in Lyons passes through the gap with the spring clip 26 passing over the top of the belt and the lip 18 passing underneath the belt, thereby fully encircling the belt.

McKnight teaches an attachment means 44 which comprises a base plate 45 permanently adhering to wall 12. On the upper end portion of the base plate 45, there is a hinging means 46 positioned near the upper surface of the object. The hinging means 46 couples a flexing arm member 48 to the base plate 45, wherein the flexing arm member 48 flexes towards and away from the base plate 45 when actuated. The arm member 48 further comprises a plurality of teeth 52 which engage the belt when the belt is placed between the base plate 45 and flexing arm member 48. When pressure is placed upon the upper plate member 54, the arm member 48 moves away from the base plate 45, thereby allowing engagement and disengagement of the attachment means 44 from the belt.

Amended Claim 1 is directed to a clip for securing an object to an article worn by a person, the object having a first surface and a second surface, wherein the first surface is adapted to be worn adjacent to the person and the second surface positioned substantially perpendicular

to the first surface, the clip comprising: a first segment and a second segment, the first segment positioned substantially adjacent to the first surface and the second segment positioned substantially adjacent to the second surface, the clip rotatably coupled with the object such that pressing the second segment toward the second surface rotates the first segment away from the first surface, the clip further comprising a selectively removeable adapter coupled with the first segment of the clip, the selectively removeable adapter positioned between the first segment of the clip and the first surface of the object and providing a flat surface therebetween.

There is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim 1. Neither Lyons nor McKnight teach a selectively removeable adapter coupled with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable adapter is positioned between the first segment and the first surface and provides a flat surface therebetween. McKnight includes a plurality of teeth between the flexing arm member and the base member, whereby the teeth secure the belt when the belt is engaged in the clip. Thus, McKnight teaches away from the present invention in amended Claim 1, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth in McKnight unuseable. Similarly, Lyons teaches away from the present invention in amended Claim 1, because placing an adapter between the plate and the surface of the object would not allow the user to place the belt through the gap 26 within the spring clip. Accordingly, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 1. Therefore, amended Claim 1 is allowable over Lyons and McKnight, individually and in combination.

Claim 2 has also rejected as being unpatentable by the above cited references. However Claim 2 is dependent on an allowable Independent Claim 1. As stated above, Claim 1 is in a condition for allowance. Accordingly, Claim 2 is also in a condition for allowance.

Amended Claim 5 is directed to a clip for securing an object to an article worn by a person, the object having a surface positioned adjacent to the person, the clip rotatably coupled with the surface and movable about the surface, the clip comprising: a first segment and a second segment and a bend through a predetermined angle between the first and second segments, wherein the first segment is positioned substantially adjacent to the surface and applying a force to the second segment causes the first segment to move away from the surface, the clip having a selectively removeable adapter coupled with the first segment and positioned between the first segment and the surface, thereby providing a uniform surface therebetween.

There is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim 5. As stated above, neither Lyons nor McKnight teach a selectively removeable adapter coupled with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable adapter is positioned between the first segment and the first surface and provides a uniform surface therebetween. In fact, McKnight teaches away from the present invention in amended Claim 5, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth in McKnight unuseable. Similarly, Lyons teaches away from the present invention in amended Claim 5, because placing an adapter between the plate and the surface of the object would not allow the user to place the belt through the gap within the spring clip. Thus, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 5. Therefore, amended Claim 5 is allowable over Lyons and McKnight, individually and in combination.

Claim 6 has also rejected as being unpatentable by the above cited references. However Claim 6 is dependent on an allowable Independent Claim 5. As stated above, Claim 5 is in a condition for allowance. Accordingly, Claim 6 is also in a condition for allowance.

Amended Claim 8 is directed to a method of attaching an object to an article worn by a person comprising providing an object having a surface positioned adjacent to the article; coupling a clip with the object about a rotatable axis, the clip having a first segment and a second segment and a bend through a predetermined angle between the first and second segments, the first segment positioned substantially adjacent to the surface wherein pressing the second segment causes the first segment to move away from the surface; and coupling a selectively removeable adapter with the first segment, wherein the selectively removeable adapter is positioned between the first segment and the surface, thereby providing a uniform surface therebetween.

There is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim 8. Neither Lyons nor McKnight teach coupling a selectively removeable adapter with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable adapter is positioned between the first segment and the first surface and provides a uniform surface therebetween. In fact, McKnight teaches away from the present invention in amended Claim 8, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth in McKnight unuseable. Similarly, Lyons teaches away

from the present invention in amended Claim 8, because positioning the adapter between the plate and the surface of the object would not allow the user to place the belt through the gap within the spring clip. Therefore, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 8. For at least these reasons, amended Claim 8 is allowable over Lyons and McKnight, individually and in combination.

Amended Claim 16 is directed to a clip for securing an object to an article worn by a person, wherein the object having a surface positioned adjacent to the article, the clip comprising: a first segment and a second segment and a bend through a predetermined angle between the first and second segments, the clip being rotatably coupled to the object at a position proximal to the second segment, wherein the first segment is positioned substantially adjacent to the surface whereby applying a force to the second segment causes the first segment to move away from the surface, the clip further including a selectively removeable uniform adapter coupled with the first segment and positioned between the first segment and the surface.

Again, there is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim-16. Neither Lyons nor McKnight teach coupling a selectively removeable uniform adapter with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable uniform adapter is positioned between the first segment and the first surface. In fact, McKnight teaches away from the present invention in amended Claim 16, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth unuseable in McKnight. Similarly, Lyons teaches away from the present invention in amended Claim 16, because positioning the adapter between the plate and the surface of the object would not allow the user to place the belt through the gap within the spring clip. Accordingly, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 16. Therefore, amended Claim 16 is allowable over Lyons and McKnight, individually and in combination.

Amended Claim 17 is directed to a clip for securing an object to an article worn by a person, the object having a surface positioned adjacent to the article, the clip comprising: a first segment and a second segment and a bend through a predetermined angle therebetween wherein the article is positioned between the first segment and the surface, the clip being rotatably coupled to the object at a position proximal to the second segment, wherein the first segment is

positioned substantially adjacent to the surface whereby applying a force to the second segment causes the first segment to move away from the surface, the clip further including a selectively removeable adapter coupled with the first segment and positioned between the first segment and the surface, thereby providing a substantially uniform surface therebetween.

There is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim 17. Neither Lyons nor McKnight teach a selectively removeable adapter coupled with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable adapter is positioned between the first segment and the first surface and provides a substantially uniform surface therebetween. In fact, McKnight teaches away from the present invention in amended Claim 17, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth in McKnight unuseable. Similarly, Lyons teaches away from the present invention in amended Claim 17, because positioning the adapter between the plate and the surface of the object would not allow the user to place the belt through the gap within the spring clip. Thus, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 17. Therefore, amended Claim 17 is allowable over Lyons and McKnight, individually and in combination.

Claim 3,4 and 7

Within the Office Action, Claims 3, 4 and 7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lyons in view of Mievis and further in view of Japanese Patent 11-40952 (hereinafter "Japan"). The Applicants respectfully traverse. Claims 3 and 4 are dependent on an allowable Independent Claim 1. As stated above, amended Claim 1 is in a condition for allowance. Accordingly, Claims 3 and 4 are also in a condition for allowance. Claim 7 is dependent on an allowable Independent Claim 5. As stated above, amended Claim 5 is in a condition for allowance. Accordingly, Claim 7 is also in a condition for allowance.

Claims 9-11

Within the Office Action, Claims 9-11 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lyons in view of McKnight and further in view of Japan. Specifically, it is stated within the Office Action that it would have been obvious to modify the teachings in Lyons in light of Japan, because Japan provides evidence of the desirability to secure a clip to an

electronic device to mount the electronic device to the waist. The Applicants respectfully traverse.

Amended Claim 9 is directed to an electronic device having a first surface positioned adjacent to an article worn by a person and a second surface substantially perpendicular to the first surface, the electronic device comprising: a clip having a first segment positioned adjacent to the first surface and a second segment configured at a predetermined angle with respect to the first segment, wherein pressing the second segment toward the second surface rotates the first segment away from the first surface, the clip having a selectively removeable adapter coupled with the first segment of the clip and positioned between the first segment and the surface, thereby providing a uniform surface therebetween.

There is no hint, suggestion or motivation to combine Lyons with McKnight, individually or in combination, to reach the present invention claimed in amended Independent Claim 9. Japan does not teach a selectively removeable adapter providing a uniform surface between the first segment and the surface. In addition, neither Lyons nor McKnight teach a selectively removeable adapter coupled with the first segment of the clip. In addition, neither Lyons nor McKnight teach that the selectively removeable adapter is positioned between the first segment and the first surface and provides a uniform surface therebetween. In fact, McKnight teaches away from the present invention in amended Claim 9, because coupling an adapter in between the teeth of the flexing arm and the base member would render the teeth unuseable in McKnight. Similarly, Lyons teaches away from the present invention in amended Claim 9, because positioning the adapter between the plate and the surface of the object would not allow the user to place the belt through the gap within the spring clip. Accordingly, there is no motivation for one skilled in the art to combine the teachings of Lyons with McKnight to reach the present invention as claimed in amended Claim 9. For at least these reasons, amended Claim 9 is allowable over Lyons, McKnight and Japan, individually and in combination.

Claims 10 and 11 are dependent on an allowable Independent Claim 9. As stated above, Claim 9 is in a condition for allowance. Accordingly, Claims 10 and 11 are also in a condition for allowance.

Claims 12-15

It is stated within the Office Action that Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK 2,339,834 to Rabenecker in view of U.S. Patent No. 5, 890,634 to Zuckerman et al. (hereinafter Zuckerman). Specifically, it is stated within the Office Action that

it would have been obvious to modify the nubbed adapter in Rabenecker so that the adapter bar is flat, as in Zuckerman. The Applicants respectfully disagree.

Claim 12 recites an adapter for providing a flat surface to a clip, wherein the clip is coupled to an object and having a segment which secures the object to an article worn by a person, the object having a surface adapted to be worn adjacent to the person, the adapter coupled to the segment and positioned between the segment and the surface of the object, wherein the adapter has an adapter length.

Rabenecker teaches a measuring instrument with a holder 1 whereby the holder secures the measuring instrument to the belt of the user. Rabenecker also teaches two cutouts 13 and 14 which are made of foam rubber, whereby the cutouts 13, 14 are used to increase the frictional force on smooth fabrics and are also removable. However, Rabenecker does not teach an adapter which provides a flat surface to a clip. Instead, Rabenecker teaches that the cutouts 13, 14 are small, round and bump-like, as shown in Figure 1.

Zuckerman teaches a clamp-type garment hanger which includes at least two clamp assemblies for securing a garment to the garment hanger. Each clamp assembly includes a pair of removeable clamping members, whereby at least one clamping member has an inner clamping surface defined at least in part by at least one gripping pad. A first side of the gripping pad includes an inner clamping surface of the one clamping member which couples the gripping pad to the clamping member. A second side of the gripping pad is presented for contact with a garment to be hung from the garment hanger. One skilled in the art would have no motivation to use Zuckerman to reach the present invention. Zuckerman is directed to a gripping pad which is coupled to a garment hanger whereby clothes are hung from the hanger. Zuckerman does not teach an adapter having a segment which secures the object to an article worn by a person. In addition, Zuckerman does not teach that the object, to which the adapter is secured, has a surface adapted to be worn adjacent to the person. Thus, Zuckerman does not render providing a flat surface to a clip as obvious in reaching the present invention.

This is a classic case of impermissibly using hindsight to make a rejection based on obviousness. The Court of Appeals for the Federal Circuit has stated that "it is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In Re Fritch, 972 F.2d, 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). As discussed above, a gripping pad coupled to a garment hanger, as Zuckerman teaches, is not equivalent to and does not render obvious the limitation of providing a flat surface to a clip. To conclude that this is obvious based on the

teachings of Zuckerman is to use hindsight based on the teachings of the present invention and to read much more into Zuckerman than its actual teachings. This is simply not permissible based on the directive from the Court of Appeals for the Federal Circuit.

It is well settled that for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met:

- 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) there must be a reasonable expectation of success; and
- 3) the prior art reference, or references, must teach or suggest all the claim limitations. MPEP § 2142; 2143.

Regarding the first element, Rabenecker is directed to a measuring instrument with a holder, whereby the holder includes two button cutouts 13, 14. In contrast, Zuckerman is directed to a garment hanger having gripping pad for securely hanging clothes. These two references are not in the same general class and thus are not even marginally related to one another. One reference is directed to coupling an instrument to the user's clothing, whereas the other reference is directed to hanging clothes from a hanger. One skilled in the art would not use generally available knowledge to even consider applying the teachings of Zuckerman to the Rabenecker to couple a flat surface adapter to a clip. Therefore, there is no hint, suggestion or motivation in Zuckerman or Rabenecker to use the flat gripping pads on the holder in Rabenecker.

Furthermore, Zuckerman teaches away from Rabenecker, because Zuckerman utilizes the gripping pads to prevent the garment from falling from the clamp assembly under the weight of the garment, whereas the cutouts in Rabenecker are only used to secure the instrument to the user's garment. In other words, Zuckerman utilizes the gripping members to overcome the force of the garment's weight, whereas Rabenecker does not use the cutouts to overcome the force of garment's weight. For at least these reasons, there is no suggestion or motivation, in Zuckerman and Rabenecker, or in the general knowledge of one skilled in the art to combine Zuckerman and Rabenecker to reach the present invention. The burden of establishing a *prima facie* case of obviousness based on the teachings of Rabenecker and Zuckerman has not been met within the Office Action. Therefore, Claim 12 is allowable over Rabenecker and Zuckerman, individually and in combination.

Claims 13-15 are also rejected as being obvious over Rabenecker in view of Zuckerman. However, Claims 13-15 are dependent on an allowable Independent Claim 12. As stated above, Claim 12 is in a condition for allowance. Accordingly, Claims 13-15 are also in a condition for allowance.

For the reasons given above, Applicant respectfully submit that the Claims 1-17 are in a condition for allowance, and allowance at an early date would be appreciated. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
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CERTIFICATE OF MAILING (37 CFR § 1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington D.C. 20231

HAVERSTOCK & OWENS LLP.

Date: 11-4-02 By: Juan D. Ruxon

Marked-Up Version Incorporating Changes

1. (Amended) A clip for securing an object to an article worn by a person, the object having a first surface and a second surface, wherein the first surface is adapted to be worn adjacent to the person and the second surface positioned substantially perpendicular to the first surface, the clip comprising: a first segment and a second segment, the first segment positioned substantially adjacent to the first surface and the second segment positioned substantially adjacent to the second surface, the clip rotatably coupled with the object such that pressing the second segment toward the second surface rotates the first segment away from the first surface, the clip further comprising a selectively removeable adapter coupled with the first segment of the clip, the selectively removeable adapter positioned between the first segment of the clip and the first surface of the object and providing a flat surface therebetween.
2. (Amended) The clip according to claim 1 wherein the first segment of the clip has an end proximal to the second segment and an end distal to the second segment, the first segment further comprising a protrusion on the distal end, the protrusion facing toward the first surface and having a predetermined length [such that the protrusion catches the article between the clip and the object].
3. (Amended) The clip according to claim 2 [further comprising an] wherein the selectively removeable adapter [coupled with the first segment of the clip, the adapter positioned between the first segment of the clip and the first surface of the object and having] has an adapter length greater than the predetermined length.
4. (Amended) The clip according to claim 3 wherein the selectively removeable adapter is formed of a frictional material.
5. (Twice Amended) A clip for securing an object to an article worn by a person, the object having a surface positioned adjacent to the person, the clip rotatably coupled with the surface and movable about the surface, the clip comprising: a first segment and a second segment and a bend through a predetermined angle between the first and second segments, wherein the first segment is positioned substantially adjacent to the surface and

applying a force to the second segment causes the first segment to move away from the surface, the clip having a selectively removeable adapter coupled with the first segment and positioned between the first segment and the surface, thereby providing a uniform surface therebetween.

6. (Amended) The clip according to claim 5 wherein the first segment of the clip has an end proximal to the second segment and an end distal to the second segment, the first segment including a protrusion on the distal end, the protrusion facing toward the surface and having a predetermined length [such that the protrusion catches the article between the clip and the object].
7. (Amended) The clip according to claim 6 [further comprising an adapter coupled with the first segment of the clip and positioned between the first segment of the clip and the surface,] wherein the selectively removeable adapter [having] has an adapter length greater than the predetermined length.
8. (Twice Amended) A method of attaching an object to an article worn by a person comprising:
 - a. providing an object having a surface positioned adjacent to the article; [and]
 - b. coupling a clip with the object about a rotatable axis, the clip having a first segment and a second segment and a bend through a predetermined angle between the first and second segments, the first segment positioned substantially adjacent to the surface wherein pressing the second segment causes the first segment to move away from the surface; and
 - c. coupling a selectively removeable adapter with the first segment, wherein the selectively removeable adapter is positioned between the first segment and the surface, thereby providing a uniform surface therebetween.
9. (Amended) An electronic device having a first surface positioned adjacent to an article worn by a person and a second surface substantially perpendicular to the first surface, the electronic device comprising: a clip having a first segment positioned adjacent to the first surface and a second segment configured at a predetermined angle with respect to the first segment, wherein pressing the second segment toward the second surface rotates the first

segment away from the first surface, the clip having a selectively removeable adapter coupled with the first segment of the clip and positioned between the first segment and the surface, thereby providing a uniform surface therebetween.

10. (Amended) The electronic device according to claim 9 wherein the first segment of the clip has an end proximal to the second segment and an end distal to the second segment, the first segment further comprising a protrusion on the distal end, the protrusion facing the first surface and having a predetermined length [such that the protrusion catches the article between the clip and the electronic device].
11. (Amended) The electronic device according to claim 10 [further comprising an adapter coupled with the first segment of the clip and positioned between the first segment and the first surface,] wherein the selectively removeable adapter [having] has an adapter length greater than the predetermined length.
16. (Amended) A clip for securing an object to an article worn by a person, wherein the object having a surface positioned adjacent to the article, the clip comprising: a first segment and a second segment and a bend through a predetermined angle between the first and second segments, the clip being rotatably coupled to the object at a position proximal to the second segment, wherein the first segment is positioned substantially adjacent to the surface whereby applying a force to the second segment causes the first segment to move away from the surface, the clip further including a selectively removeable uniform adapter coupled with the first segment and positioned between the first segment and the surface.

17. (Amended) A clip for securing an object to an article worn by a person, the object having a surface positioned adjacent to the article, the clip comprising: a first segment and a second segment and a bend through a predetermined angle therebetween wherein the article is positioned between the first segment and the surface, the clip being rotatably coupled to the object at a position proximal to the second segment, wherein the first segment is positioned substantially adjacent to the surface whereby applying a force to the second segment causes the first segment to move away from the surface, the clip further including a selectively removeable adapter coupled with the first segment and positioned between the first segment and the surface, thereby providing a substantially uniform surface therebetween.